



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/743,523

12/23/2003

Honjung Lee

118109

7335

25944

7590

10/30/2008

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

RAE, CHARLESWORTH E

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

10/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,523	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> CHARLESWORTH RAE	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22, 24-59 and 61-78 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 24-59, 61-73, 76-78, 84, and 87-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 74, 75, 79- 80, 85-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/17/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Acknowledgement is made of applicants' filing of the instant application as a Request for Continued Examination (RCE) under 37 CFR 1.1114, filed 07/17/08.

#### **Status of the Claims**

Claims 1-22, 24-59, 61-80, 84-88 are currently pending in this application.

Claims 1-22, 24-59, 61-73, 76-78, 84, and 87-88 are withdrawn for being directed to non-elected subject matter.

Claims 74-75, 79-80, and 85-86 are under examination.

#### **Claim of Priority**

Receipt of a non-English certified copy of the foreign priority application received 8/26/04 is acknowledged.

#### **Response to applicant's arguments/remarks**

##### Objection to the Specification

The objection to the Title of the specification is withdrawn in view of the amendment.

##### Rejection under 103(a)

This rejection is withdrawn as applicant's arguments and claim amendment are found to overcome the rejection (see applicant's Response, received, 07/17/08, at pages 14-18).

##### Nonstatutory obviousness-type double patenting (ODP) rejection

These rejections are maintained as applicant's arguments and claim amendment are not found to be sufficient to overcome these rejections made of record in the Office action, mailed 03/17/08, pages 9-10 (see applicant's Response, pages 18-19).

## **Rejections**

### **Claim rejections – 35 USC 103(a)**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 1611

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Deleted: 3

**Claims 74-75, 79-80, and 85-86 are rejected under 103(a) for being unpatentable over Okada et al. (US Patent 5,463,009) and Suzuki et al. (US Patent 6,759,052), in view of Yau (US Patent 6,109,921), in further view of Giron et al. (US Patent Application Pub. No. 2003/0067545 A1) and Chapman et al. (US Patent 6,121,192).**

Claim 74 recites "[a] method for making up dark skin comprising applying to the skin at least one composition according to claim 1, wherein the dark skin has a mean lightness  $L^*$  of less than 60, as measured on a forehead, cheekbones and chin, in a CIE 1976 colorimetric space." The composition of claim 1 encompasses "a composition of foundation type comprising, in a physiologically acceptable medium, at least one colouring agent having reflectance of a yellow or orange coloration in a range from 550 to 675 nm and reflective particles comprising at least one nacre, said composition having a hue angle  $h$  ranging from 40 degrees to 70 degrees, and a saturation  $C^*$  ranging from 20 to 50." Claim 75 recites "at least one composition according to claim 37, wherein the dark skin has a mean lightness  $L^*$  of less than 60, as measured on a forehead, cheekbones and chin, in a CIE 1976 colorimetric space." Claim 79 recites "comprising applying to the skin the first composition and the second composition according to claim 76 wherein; wherein the dark skin has a mean lightness  $L^*$  of less than 60, as measured on a forehead, cheekbones and chin, in a CIE 1976 colorimetric space." Claim 80 recites "comprising applying a first coat of the first and second

Art Unit: 1611

compositions followed by applying, over at least a portion of said first coat, a second coat of the other of the first and second compositions." Claim 85 recites "[a] method for making up dark skin, the method comprising: applying to the skin a first composition comprising, in a first physiologically acceptable medium, at least one coloring agent having a reflectance of a yellow or orange coloration in a range from 550 to 675 nm, and a second composition comprising, in a second physiologically acceptable medium, at least reflective particles comprising at least one nacre, wherein: wherein the dark skin has a mean lightness  $L^*$  of less than 60, as measured on a forehead, cheekbones and chin, in a CIE 1976 colorimetric space." Claim 86 recites "comprising applying a first coat of one of the first and second compositions followed by applying, over at least a portion of said first coat, a second coat of the other of the first and second compositions."

Okada et al. (US Patent 5,463,009) teach fluorine-modified silicone derived perfluoroalkyl water-repellant cosmetics for use in protecting the skin from water or for preventing makeup up from getting disordered by water or sweat in the form, for example, cosmetics for foundation (col. 1, line 17 col. 2, line 19; see cols. 11-13, Examples 4-8). Okada et al. disclose an evaluation method for applying the foundation for wearability, retention, and feel on the skin (col. 11, line 52 to col. 12, line 18). Okada et al. exemplify compositions comprising iron oxide red, yellow, and black (= applicant's elected coloring agent), fluorine compounded-treated pigments, glycerin and water (cols. 11-12, Table 2). Okada et al. teach that the retention of the foundation was

Art Unit: 1611

evaluated in terms of the degree of removal of the foundation from the skin 8 hours after application. Okada et al. teach that other cosmetic ingredients may be included in the composition, including colorants, such as organic and inorganic pigments, organic dyes, as well as fluorine compound- treated pigment to prevent makeup from getting disordered due to sebum (col. 5, lines 25-49). Okada et al. exemplify compositions comprising iron oxide red, yellow, and black (= applicant's elected coloring agent), fluorine compounded-treated pigments, and water (cols. 11-12, Table 2).

Okada et al. do not teach compositions comprising mica brown iron oxide (i.e. applicant's elected reflective particle species), wherein said composition have and is silent regarding methods for making up dark skin or lightening dark skin comprising a composition having hue angle  $h$  ranging from 40 degrees to 70 degrees, an a saturation  $C^*$  ranging from 20 to 50.

Suzuki et al. (US Patent 6,759,052) teach a liquid eye shadow cosmetic composition comprising iron oxide coated titanated mica, perfluoropolyether, purified water (col. 22, Example 32).

Yau (US Patent 6,109,921) teaches methods for making up dark skin using a mannequin model, including the application of foundations (col. 6, lines 14-47). Yau suggest that differences due to ethnic and/or racial origin need to be considered when applying makeup (col. 6, lines 14-47).

Giron et al. (US Patent Application Pub. No. 2003/0067545 A1) is added to show the general state of knowledge regarding use of CIE 1976 color scheme. Giron et al. teach a calibration device that allows the acquisition of calorimetric coordinates at a

Art Unit: 1611

point of the image, which can be part of a reference colorimetric space, such as, for example the space according to the CIE 1976 CIELAB system; the calibration device permits the measurement of differences in color, shade and clarity, and is advantageous when a person's appearance is compared before and after a treatment with a care product or an application of a makeup.

Chapman et al. (US Patent 6,121,192) is added to show the general state of knowledge regarding compositions comprising colorants and use of CIE and hue angles as parameters for expressing colors (col. 1, line 52 to col. 2, line 51). Champman et al. teach orange ink manufactured as a reference material and its CEILAB color coordinates measured at a status T density of 1.49, wherein CIELAB was used to express colors in terms of three parameters.  $L^*$ ,  $a^*$ , and  $b^*$  (cols. 9-10). A plot of  $a^*$  versus  $b^*$  values for a color sample can be used to accurately show where that sample lies in color space i.e. hue (col. 10, lines 19-37). Champman et al. teach that color differences can also be expressed in terms of a hue angle and saturation  $C^*$  (col. 10, lines 39-56). Champman et al. teach that an orange dye-donor element provides a close match to an orange printing ink control (col. 10, lines 57-60). It is noted that Chapman is being relied upon to only show that methods for determining CIELAB color coordinates with respect hue angles, and saturation  $C^*$  are known.

It is noted that active method steps of applying a composition comprising both coloring agents and reflective particles in the same composition are considered to be the functional equivalent of applying a composition/coat comprising the coloring agent as a separate composition (= a first composition or first coat) and applying a second



Art Unit: 1611

composition (or second coat) comprising the reflective particles because the end treatment effect would be the same in the absence of unexpected results. Further, it is the examiner's position that it would have been routine in the cosmetic art at the time the invention was made to modify the reflectance of the composition without undue experimentation.

It would have obvious to a person of skill in the art at the time the invention was made to add the iron oxide coated titanated mica (= reflective material) composition as taught by Suzuki et al. to the composition comprising iron oxide (= coloring agent), and water (= physiologically acceptable medium) taught by Okada et al. for additive coloring effects. One would have been motivated to add the iron oxide coated titanated mica composition to the composition comprising iron oxide (= coloring agent), and water (= physiologically acceptable medium) because Okada et al. suggest that colorants may be added to the composition. Also, it would have been obvious to a person of skill in the art at the time the invention was made to treat dark skin as taught by Yau by applying the composition comprising iron oxide and iron oxide coated titanated mica to said skin for makeup effects. One would have been motivated to treat dark skin via by applying the composition via the mannequin model because Yau suggest that ethnic/racial differences need to be considered when applying makeup and both Okada et al. and Suzuki et al. teach makeup compositions. Further, it would have been obvious to a person of skill in the art at the time the invention was made to use the CIE 1976 scheme taught by Giron et al. to determine the color coordinates of the coloring agents of the composition. One would have been motivated to use the CIE 1976 scheme to

Art Unit: 1611

determine the color coordinates of the coloring agent of the composition because Giron et al. teach a calibration device that allows the acquisition of calorimetric coordinates at a point of the image, which can be part of a reference colorimetric space, such as, for example the space according to the CIE 1976 CIELAB system calibration device permits the measurement of differences in color, shade and clarity, and which is advantageous when a person's appearance is compared before and after a treatment with a care product or an application of a makeup and Okada et al., Suzuki et al., and Yau all directed to methods of applying makeup. In addition, it would have been obvious to a person of skill in the art at the time the invention was made to modify the hue angle and saturation  $C^*$  of the composition as taught by Chapman et al., including the instant claimed hue angle and saturation  $C^*$ , for cosmetic effects. Although Champman is directed to ink composition, its teaching of methods for determining CIELAB color coordinates with respect hue angles, and saturation  $C^*$  is considered to be relevant regarding the determination of CIELAB coordinates. One would have been motivated to modify the hue angle and saturation  $C^*$  of the composition for cosmetic effects because both Chapman et al. and Giron et al. teach CIE 1976 color scheme, while both Okada et al., Suzuki et al. and Yau are directed to methods of applying makeup compositions comprising coloring agents. Hence, the cited art is found to be capable of performing the desired function.

Thus, a person of skill in the art at the time the invention was made would have found it obvious to create the instant claimed invention with reasonable predictability.

***Nonstatutory Obviousness-Type Double-Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 74-75, 79-80, and 85-86 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32-34 of copending U.S. Patent Application No. 11/172,977 (Appl. '977), in view of Okada et al. (US Patent 5,463,009), Suzuki et al. (US Patent 6,759,052), and Yau (US Patent 6,109,921), and in further view of Giron et al. (US Patent Application Pub. No. 2003/0067545 A1) and Chapman et al. (US Patent 6,121,192).**

The above discussions of Okada et al. (US Patent 5,463,009), Suzuki et al. (US Patent 6,759,052), and Yau (US Patent 6,109,921), and in further view of Giron et al. (US Patent Application Pub. No. 2003/0067545 A1) and Chapman et al. (US Patent 6,121,192). Reference claim 32 is directed towards a process for making up skin comprising a composition comprising a dye. Unlike the instant claims, the reference claims are not directed to a method of making up dark skin comprising applying a composition comprising reflective particles. However, it would have been obvious to a person of skill in the art at the time the invention was made to add reflective particles as taught by the prior cited art for application to dark skin for additive cosmetic effect. One would have been motivated to add reflective particles to the composition for its additive cosmetic effect because the reference claims and the cited art are concerned with making up of the skin.

Thus, a person of skill in the art at the time the invention was made would have deemed the instant claims to be an obvious variant of the reference claims in view of the cited prior art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims of the copending applications have not in fact been patented.

**Claims 74-75, 79-80, and 85-86 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7, and 39-41 of US Patent 6,451,294, in view of Okada et al. (US Patent 5,463,009), Suzuki et al. (US Patent 6,759,052), and Yau (US Patent 6,109,921), and in further view of Giron et al. (US Patent Application Pub. No. 2003/0067545 A1) and Chapman et al. (US Patent 6,121,192).**

The above discussions of Okada et al. (US Patent 5,463,009), Suzuki et al. (US Patent 6,759,052), and Yau (US Patent 6,109,921), and in further view of Giron et al. (US Patent Application Pub. No. 2003/0067545 A1) and Chapman et al. (US Patent 6,121,192).

Reference claim 7 is directed towards a method for making up human skin comprising applying a composition process for making up skin comprising a composition comprising a dye. Unlike the instant claims, the reference claims are not directed to a method of making up dark skin comprising applying a composition comprising reflective particles. However, it would have been obvious to a person of skill in the art at the time the invention was made to add reflective particles as to taught by the prior cited art for application to dark skin for additive cosmetic effect. One would

Art Unit: 1611

have been motivated to add reflective particles to the composition for its additive cosmetic effect because the reference claims and the cited art are concerned with making up of the skin.

Thus, a person of skill in the art at the time the invention was made would have deemed the instant claims to be an obvious variant of the reference claims in view of the cited prior art.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 9 a.m. to 5:30 p.m. Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau, can be reached at 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-217-9197 (toll-free). If you would like

Art Unit: 1611

assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8 October 2008

/C. R./

Examiner, Art Unit 1611

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611